

Application No. 09/939276
Page 9

Amendment
Attorney Docket No. S63.2H-9828-US01

Remarks

This Amendment is in response to the Office Action dated August 21, 2003.

Claims 1 - 54 are pending in this application. Claims 9 - 16 and 18 - 54 have been withdrawn. The Office Action rejected claims 1 - 8 and 17 under 35 USC § 112, first paragraph, as not enabled, and rejected claims 1 - 8 under 35 USC § 102 over US 6254609 to Vrba et al. (hereinafter "Vrba").

By this Amendment, claim 1 is amended. The specification is amended for clarification purposes. No new matter has been added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Claim Rejections – 35 USC § 112

The Office Action rejects claims 1 - 8 under 35 USC § 112, first paragraph for not enabling one of ordinary skill in the art to make and/or use the invention. Applicants assert that in light of amendments made to claim 1, these rejections are moot.

The Office Action also rejects claim 17 under 35 USC § 112, first paragraph. The specification has been amended to recite that at least a portion of the distal outer tube 105 and/or at least a portion of the midshaft tube 144 may comprise a radiopaque material.

"The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter." *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).

Claim 17 clearly encompassed the embodiment of Figures 11 and 12 wherein at least a portion of at least one of the distal outer tube and the midshaft tube is radiopaque.

Accordingly, Applicants request withdrawal of the rejections under 35 USC § 112.

Claim Rejections – 35 USC § 102

The Office Action rejects, under 35 USC § 102, claims 1 - 8 over Vrba.

Applicants assert that Vrba does not disclose or suggest a medical device having a support member, a first tubular member and a second tubular member, wherein the first tubular

Application No. 09/939276
Page 10

Amendment
Attorney Docket No. S63.2H-9828-US01

member is positioned immediately adjacent to at least a portion of the support member and the second tubular member is positioned immediately adjacent to at least a portion of the first tubular member, wherein *a portion of the first tubular member is welded to a portion of the second tubular member*, as recited in independent claim 1.

Vrba discloses a self-expanding stent delivery system having an inner sheath 140 and an outer sheath 144. The Examiner has read claim 1 onto Vrba such that the first tubular member corresponds to the Vrba inner sheath 140 and the second tubular member corresponds to the Vrba outer sheath 144. However, Vrba does not disclose or suggest welding the inner sheath 140 to the outer sheath 144, as would be required to anticipate claim 1.

Therefore, Applicants assert that Vrba does not render claim 1 unpatentable.

Further, Vrba does not discuss radiation, and clearly does not explicitly recite a "support member constructed and arranged to substantially reflect radiation at one or more frequencies absorbable by at least one of the first tubular member and second tubular member," as recited in claim 1.

In light of the above, Applicants respectfully submit that independent claim 1 defines patentable subject matter. Claims 2 – 8 and 17 depend from independent claim 1 and therefore also define patentable subject matter for at least the reasons discussed above. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 USC § 102.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1 – 8 and 17 are earnestly solicited.

Application No. 09/939276
Page 11

Amendment
Attorney Docket No. S63.2H-9828-US01

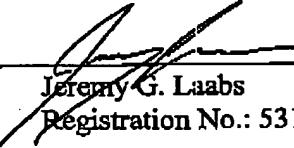
Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respecifuly submitted,

VIDAS, ARRETT & STEINKRAUS

Date: 11/12, 2003

By:


Jeremy G. Laabs

Registration No.: 53170

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

f:\wpwork\jg\09828us01_amd_20030922.doc